

Serial No. 10/789,956
Docket No. SHE0081.00

REMARKS

I. The Restriction Requirement:

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claims 1-30, drawn to a plurality of conjugates, each conjugate having one to three water-soluble polymers covalently attached to a Factor VIII moiety;
- II. Claims 31-57, drawn to a composition comprising a plurality of monoPEGylated Factor VIII moiety conjugates;
- III. Claim 58, drawn to a method for making a conjugate comprising contacting under conjugation conditions, a Factor VIII moiety with a polymeric reagent; and
- IV. Claims 59-61, drawn to a method of treating a patient in need of Factor VIII therapy.

II. Response to the Restriction Requirement:

In response, Applicants hereby elect Group I, claims 1-30, *with traverse*.

Traverse is premised on the ground that a combined search of all four Groups does not impose an undue burden on the Examiner. As stated in the Manual of Patent Examining Procedure ("MPEP"),

[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

See M.P.E.P. Section 803.

Here, each of Group I, II and III has been classified in the same class (i.e., class 530), thereby suggesting that a search of this one class is simultaneously useful for each of these three Groups. Moreover, the claims in Group IV refer to compositions of Group I (claim 1) and Group II (claim 31). In view of the above, it is therefore believed that search and examination of the entire application can be made without serious burden to the Examiner. Consequently, reconsideration and removal of the requirement for restriction are respectfully requested.

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III. The Information Disclosure Statement:

On October 25, 2004, Applicants transmitted an Information Disclosure Statement (IDS) to the U.S. Patent and Trademark Office. It is Applicants' position that the filing of this IDS satisfied the requirements of 37 C.F.R. §1.97 and 37 C.F.R. §1.98. In particular, Applicants believe that the IDS was filed prior to a first Office Action on the merits inasmuch as the present Restriction Requirement does not qualify as an action on the merits. See Section 609 of the MPEP. Consequently, Applicants respectfully request an initialed copy of the IDS forms indicating consideration of the references disclosed therein be returned to the undersigned.

IV. Conclusion:

In view of the foregoing, Applicants submit that the pending claims satisfy the requirements of patentability and are therefore in condition for allowance. Consequently, a prompt mailing of a Notice of Allowance is earnestly solicited.

If a telephone conference would expedite the prosecution of the subject application, the Examiner is requested to call the undersigned at (650) 620-5506.

Respectfully submitted,
Nektar Therapeutics

Date: November 2, 2004

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